

REMARKS

Summary of the Office Action

Claims 25-31, 33, 34, 36, 38, and 39 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 25-31, 33, 34, 36, 38, and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yao et al. (US, 2003/0100059).

Summary of Response to the Office Action

Claims 25, 27-30, 33, and 34 are amended to further define the invention and new claims 40-41 are added. Claims 1-24, 32, and 35-39 are canceled without prejudice or disclaimer. Accordingly, claims 25-31, 33, 34, 40, and 41 are presently pending for consideration.

Inconsistency in the Action with respect to claim 35

Claim 35 was cancelled previously in the Amendment accompanying the RCE filed on June 9, 2006. Accordingly, Applicants believe that the identification of “claim 35” referenced on page 2 of the Office Action was actually directed to the independent claim 25. Accordingly, Applicants’ Amendment is directed toward the presumption that independent claims 25 and 30 are rejected under 35 U.S.C. § 112, second paragraph.

All claims complies with 35 U.S.C. § 112

In the Office Action, claims 25-31, 33, 34, 36, 38, and 39 stand rejected under § 35 U.S.C. 112, second paragraph, as being indefinite. Applicants respectfully submit that since claims 38 and 39 have been cancelled that the rejection of claims 38 and 39 is moot. In addition, claims 25, 27-30, 33, and 34 are amended to satisfactorily reduce “means-type” features.

Accordingly, Applicants respectfully submit that newly amended claims 25, 27-30, 33, and 34 and previously presented claims 26 and 31 comply with the requirement under 35 U.S.C. §112, second paragraph. Thus, Applicant respectfully request that the rejections of claims 25-31, 33, 34, 36, 38, and 39 under 35 U.S.C. §112, second paragraph, be withdrawn.

All Claims Define Allowable Subject Matter

In the Office Action, claims 25-31, 33, 34, 36, 38, and 39 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Yao et al. (US, 2003/0100059). Applicants respectfully traverse the rejection of claims at least for the following reasons.

With respect to independent claims 25 and 30, as amended, Applicants respectfully assert that Yao et al. does not teach or suggest an intracellular-reaction measuring apparatus including at least the features of specifying member specifies the expressed cells and cells (or cell colonies) adjacent thereto on the basis of extracted result extracted by the first and second extracting members.

When intracellular reactions of the expressed cells are to be accurately analyzed, it was commonly thought that only reacted light emitted from the expressed cell/s is to be detected and analyzed. It was also commonly thought that reacted light emitted from the cells other than the expressed cells are not detected. As a result of repeated experiments in the intracellular reaction measurement, Applicants found out that not only the expressed cell/s containing the stated protein but also the adjacent (i.e., closely adhered) cells to the expressed cell/s exhibit the same reactions as that of the expressed cells. Therefore, to accurately measure the reactions of the expressed cell/s, reaction light emitted from both the expressed cell/s and the adjacent to the expressed cell/s are detected (original specification, page 23, line 21 to page 31, line 11).

In contrast to the Applicants' claimed invention, the technique disclosed by example 1 of Yao et al. (paragraph [0142] and FIG. 2) includes detecting the reaction of single cell (i.e., a single cell expressing the GFP-positive reaction). However, it appears that neighboring cells to that reacted single cell do not exhibit GFP-positive reaction. In other words, the technique of Yao et al. does not measure and analyze the reaction of the neighboring cells in order to analyze the reaction of the single cell. Thus, Applicants respectfully assert that Yao et al. fails to teach or suggest the at least the features of "a first extracting member that extracts expressed cells emitting said first light on the basis of a detection signal of said first light detected by said photo-detecting means; a second extracting member that extracts all cells emitting said second light; a specifying member that specifies a cell region containing said expressed cells extracted by the first extracting member with a higher proportion than a stated standard among said all cells extracted by the second extracting member, which includes cells not having the stated protein."

Accordingly, in light of the arguments presented above, Applicant respectfully submits that the rejections under 35 U.S.C. § 102(e) should be withdrawn because Yao et al. fails to teach or suggest at least the features including measuring the reaction light emitted from the expressed cells as well as the reaction light emitted from the cells adjacent to the expressed cells recited in amended independent claims 25 and 30, and hence dependent claims 26-29, 31, 33, and 34, which depend from respective one of claims 25 and 30. Moreover, Applicant respectfully submits that dependent claims 26-29, 31, 33, and 34 are allowable for at least the same reasons as set forth above with regard to amended independent claims 25 and 30 upon which they respectfully depend, as well as the individual features they recite.

New Claims 40 and 41

Applicants added new claims 40 and 41. Applicant respectfully submits that new claims 40 and 41 further define the subject matter of the current invention. Thus, Applicant respectfully requests consideration of newly added claims 40 and 41.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application, withdrawal of all rejections, and the timely allowance of all pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.R.R. § 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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Date: February 21, 2007

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